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10/747,623	12/30/2003	Noel Enete	06975-388001	2832

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ART UNIT	**PAPER NUMBER**
2173	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/747,623	ENETE ET AL.	
	Examiner	Art Unit	
	Stephen Alvesteffer	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2007 and 16 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-27 and 29-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-27 and 29-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20070716*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to the amendment filed June 13, 2007 in which the claims were amended. Claims 1, 3, 4, 8, 15, 16, 19-27, 29-31, 33, 34, 36-38, and 41-52 are amended. Claims 2 and 28 are cancelled. Claims 53-56 are new. Claims 1, 26, 27, and 52 are independent claims. Claims 1, 2-27, and 29-56 remain pending. The Information Disclosure Statement filed July 16, 2007 has been considered by the examiner.

Claim Objections

Claims 22, 54, and 56 is objected to because of the following informalities:

- In claim 22 line 2, "instant recipient at the host system" should be corrected to –instant message recipient at the host system—.
- In claim 54 line 7, "receiving **the a** request" should be corrected to – receiving **the** request—
- In claim 56 line 7, "receiving **the a** request" should be corrected to – receiving **the** request—

Appropriate correction is required.

Claims 49-51 are objected to because there is no antecedent basis for "determining capabilities". The examiner believes that claims 49-51 were intended to depend on claim 48 instead of claim 46. For the purpose of expediting prosecution of

this application, the examiner will interpret claims 49-51 as depending on claim 48 instead of claim 46. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27, 29-52, 55, and 56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite non-functional descriptive material because no execution of the instructions is recited. Non-functional descriptive material recorded on a computer readable medium is not statutory since no requisite functionality is present to satisfy the practical application requirement. *See MPEP 2106.01.*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, 8-11, 19-21, 26-32, 34-37, 45-47, and 52-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashemi, United States Patent Application Publication number 2003/0212804.

Regarding claim 1, Hashemi teaches a computer implemented method for sending a video clip in an instant messaging communications session, the method comprising: storing, on a host system, a collection of video clips available to be sent to instant message recipients in instant messaging communications sessions (see paragraph [0058]; "*the list of media clips may advantageously be exchanged through the central server 102, which can also be configured to store the list of media clips*"); establishing an instant messaging communications session between an instant message sender and an instant message recipient (see paragraph [0047]; "*One embodiment permits the users within a peer group to simultaneously chat while a media clip may advantageously be streamed from one user in the peer group to other users in the peer group*"); providing the instant message sender with access to the collection of video clips stored on the host system (see paragraph [0047]; "*The exemplary media clip browse window 204 displays a list of peers that may advantageously be signed in or logged onto the central server 102 and displays the media clips from the peers that may advantageously be available for streaming*"); receiving, at the host system, a request from the instant message sender for a particular video clip from among the collection of video clips stored on the host system to be delivered to the instant message recipient (see paragraph [0027]; "*The exemplary user computer 130 can also send a stream of a media clip to another user computer*"); in response to receiving the request from the

instant message sender for the particular video clip to be delivered to the instant message recipient, sending a video clip identifier corresponding to the particular video clip to the instant message recipient (see paragraph [0081]; "*The File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612*", a media clip identifier inherently must be sent to the instant message recipient); after sending the video clip identifier corresponding to the particular video clip to the instant message recipient, receiving, from the instant message recipient, a request for the particular video clip (see paragraph [0025]; "*A media clip selection module 136 permits a user to select which media clips from a list of media clips may be received in a stream from another user computer*"); in response to receiving the request for the particular video clip, accessing the particular video clip from the collection of video clips stored at the host system and communicating the particular video clip from the host system to the instant message recipient for rendering (see paragraph [0039]; "*Streaming of a media clip advantageously permits the computer receiving the stream to play or display the media clip while the media clip transfers and before an entire file has been transferred*").

Regarding claim 3, Hashemi teaches that receiving the request from the instant message sender from the particular video clip to be delivered to the instant message recipient comprises receiving a request that is generated in response to a communication from the instant message sender to the instant message recipient (see paragraph [0039]; "*In one embodiment, when a user computer communicates with another user computer to send a stream of a media clip*").

Regarding claim 4, Hashemi teaches that receiving the request from the instant message sender for the particular video clip to be delivered to the instant message recipient comprises receiving the identifier corresponding to the particular video clip (see paragraph [0081]; "*The File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612*", a media clip identifier inherently must be sent to the instant message recipient).

Regarding claim 5, Hashemi teaches that receiving the identifier further comprises receiving an identifier comprising a location on the host system of the selected video clip (see paragraph [0081]; "*The File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612*", a media clip identifier includes the location of the media clip on the host system).

Regarding claim 6, Hashemi teaches that the identifier further comprises a file name (see paragraph [0081]; "*The File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612*", a media clip identifier includes the filename of the media clip).

Regarding claim 8, Hashemi teaches that receiving the identifier comprises receiving the identifier in response to a communication from the instant message sender to the instant message recipient (see paragraph [0039]; "*In one embodiment, when a*

user computer communicates with another user computer to send a stream of a media clip", the identifier inherently must be sent before the media clip can be accessed).

Regarding claim 9, Hashemi teaches that the host comprises a server authorized as a partner to an instant messaging host (see paragraph [0058]; "*the list of media clips may advantageously be exchanged through the central server 102, which can also be configured to store the list of media clips*", Hashemi's invention utilizes centralized peer-to-peer file sharing).

Regarding claim 10, Hashemi teaches that storing the video clips comprises storing one or more still photographs and a sound track (see paragraph [0021]; "*A media clip includes at least a portion of an audio work or a video work, which has been recorded or stored*", a video clip is inherently the same as one or more still photographs and a sound track).

Regarding claim 11, Hashemi teaches that storing the video clips comprises storing an animation sequence (see paragraph [0021]; "*A media clip includes at least a portion of an audio work or a video work, which has been recorded or stored*", a video clip can reasonably be interpreted as being the same as an animation sequence).

Regarding claim 19, Hashemi teaches determining whether the particular video clip is an official item; and displaying the particular video clip if the video clip is an official item. The specification of the instant application is silent as to how to differentiate an "official item" from a regular item. Therefore, this dependent claim is not patentably distinct from its parent claim and does not recite any additional limitations.

Claims 20 and 21 recite significantly the same limitations as claim 1 and are therefore rejected under the same rationale.

Claim 26 recites a method with substantially the same limitations as the method of claim 1. Therefore, claim 26 is rejected under the same rationale.

Claims 27-32, 34-37, and 45-47 recite a computer program with substantially the same limitations the method of claims 1-6, 8-11, and 19-21, respectively. Therefore, the claims are rejected under the same rationale

Claim 52 recites a computer program with substantially the same limitations as the method of claim 26. Therefore, claim 52 is rejected under the same rationale.

Regarding claim 53, Hashemi teaches that providing the instant message sender with access to the collection of video clips stored on the host system comprises sending a list of the available video clips to the instant message sender (see paragraph [0025]; "*A media clip selection module 136 permits a user to select which media clips from a list of media clips may be received in a stream from another user computer*").

Regarding claim 54, Hashemi teaches receiving, at the host system, a request from the instant message sender to preview the particular video clip from the collection of video clips stored on the host system; in response to receiving the request to preview the particular video clip, accessing the particular video clip from the collection of video clips stored on the host system and communicating the particular video clip from the host system to the instant message sender for previewing, wherein receiving the request from the instant message sender for the particular video clip to be delivered to the instant message recipient occurs after the particular video clip has been sent to the

instant message sender for previewing. The invention as taught by Hashemi is capable of allowing the sender to view a video clip prior to sending it to another user via an instant message (chat) application (see paragraph [0066]; "*The selected media clips can further include media clips that may advantageously be locally accessible from the user's computer*"; see also paragraph [0047]; "*One embodiment permits the users within a peer group to simultaneously chat while a media clip may advantageously be streamed from one user in the peer group to other users in the peer group*").

Claims 55 and 56 recite substantially the same limitations as claims 53 and 54, respectively. Therefore, the claims are rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi (2003/0212804) *supra* and Van Hoff et al. (hereinafter Van Hoff), United States Patent number 5,919,247.

Regarding claim 7, Hashemi teaches all the limitations of claim 7 except that receiving the identifier comprises receiving an identifier created for the selected video clip based upon the application of an algorithm to at least a portion of the selected video clip. Van Hoff teaches using a cryptographic hash algorithm such as Message-Digest

Algorithm 5 (MD5) to verify the identity of a file, which was a well known method to persons of ordinary skill in the art at the time the invention was made (see Van Hoff column 6 lines 14-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the cryptographic hash algorithm method taught by Van Hoff with the method of Hashemi in order to verify the identities of requested video clips.

Claim 33 recites a computer program with substantially the same limitations as the method of claim 7. Therefore, claim 33 is rejected under the same rationale.

Claims 12-15 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi (2003/0212804) *supra* and Snyder et al. (hereinafter Snyder), United States Patent number 6,070,171.

Regarding claims 12-15, Hashemi teaches all the limitations of claims 12-15 except that storing the video clips comprises storing one or more video clips configured to expire upon the occurrence of a predetermined event; the predetermined event comprises passage of a predetermined length of time or the passage of a predetermined date; the predetermined event comprises a predetermined number of uses; determining whether a video clip has expired, and disallowing access to the video clip if the video clip has expired. However, Snyder teaches disallowing access to software content after a predetermined duration or number of uses (see Snyder column 12 lines 44-49; "*Other examples of Software Payloads (SP) for use with the present invention are on game disks and film on CDROMs whereby copying is prevented and/or*

time of use is constrained. Also, rental software can use the invention to limit the duration of use and/or the number of uses"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to likewise disallow access (as taught by Snyder) to other media content such as video (as taught by Hashemi) for the purpose of protecting the intellectual property rights of video.

Claims 38-41 recite a computer program with substantially the same limitations as the method of claims 12-15. Therefore, the claims are rejected under the same rationale.

Claims 16-18 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi (2003/0212804) *supra* and Heikes et al. (hereinafter Heikes), United States Patent Application Publication number 2003/0225847.

Regarding claims 16-18, Hashemi teaches all the limitations of claims 16-18 except determining whether a video clip has been banned, and disallowing access to the video clip if the video clip has been banned; determining whether the video clip has been banned comprises determining whether the video clip has been banned based on a report by a user; and determining whether the video clip has been banned comprises determining whether the video clip has been banned based on a violation of a term of a service agreement. However, Heikes teaches determining whether a wallpaper image has been banned based on a report by a user or a violation of a term of a service agreement, and disallowing access to the wallpaper image if it has been banned (see Heikes paragraph [0009]; "*If it determined that the wallpaper has been banned, sending*

of the wallpaper may be disallowed. The determination of whether the wallpaper has been banned may be based, for example, on a report by a user or on a violation of a term of service agreement"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to impose the same policies for banning images as taught by Heikes on the media clips of Hashemi for the purpose of enforcing a service agreement for the use of the media clips.

Claims 42-44 recite a computer program with substantially the same limitations as the method of claims 16-18. Therefore, the claims are rejected under the same rationale.

Claims 22-25 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi (2003/0212804) *supra*, and Video: An empirical study of realvideo performance across the internet, from Proceedings of the 1st ACM SIGCOMM Workshop on Internet Measurement IMW '01, by Yubing Wang, Mark Claypool, and Zheng Zuo (hereinafter Wang).

Regarding claims 22-25, Hashemi teaches all the limitations of claims 22-25 except for determining capabilities of the instant messaging participant at the host system by determining a data connection speed, identifying hardware associated with the instant messaging participant system, and identifying software associated with the instant messaging participant system, then determining an appropriate version from one or more versions of the selected video clip based upon the determined capabilities and accessing the appropriate version of the selected video clip. Wang teaches determining

capabilities of the instant messaging participant at the host system by determining a data connection speed, identifying hardware associated with the instant messaging participant system, and identifying software associated with the instant messaging participant system (see page 298 paragraph 2), then determining an appropriate version from one or more versions of the selected video clip based upon the determined capabilities and accessing the appropriate version of the selected video clip (see page 297, Bandwidth Characteristics section). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the methods taught by Wang with the invention taught by Hashemi in order to provide video clips that are appropriate for each user's system.

Claims 48-51 recite a computer program with significantly the same limitations as claims 22-25. Therefore, they are rejected under the same rationale.

Response to Arguments

The amendments to claims 1, 4, 15, 16, and 19 have differentiated claims of the instant application from the claims of co-pending Application Serial No. 10/334,129. Therefore, the provisional Double Patenting rejection of claims 1, 4-5, 7, 9-16, and 19 is withdrawn.

Claims 23-25 have been amended to properly depend upon claim 22. Therefore, the objections to claims 23-25 have been withdrawn.

Claims 27-52 were previously rejected under 35 U.S.C. § 101 for reciting a computer readable medium which may include a propagated signal (see instant application specification page 4, lines 2-4). Applicant amended claims 27 and 29-52 to recite a "tangible computer readable medium". Because there is no explicit definition of a "tangible computer readable medium" in the specification, "tangible computer readable medium" will be interpreted as comprising only tangible mediums such as "a disc, a client device, a host device", but not intangible mediums such as "a propagated signal". As such, the previous rejection of claims 27-52 under 35 U.S.C. § 101 has been withdrawn.

Applicant's arguments with respect to claims 1, 3-27, and 29-52 have been considered but are moot in view of the new ground(s) of rejection.

Applicant asserted that the Morpheus reference used in the previous Office Action does not describe or suggest enabling users to send and/or receive video clips in instant messaging communications sessions. The new art applied, Hashemi (2003/0212804) *supra*, teaches an application which enables users to send and/or receive video clips in instant messaging communications sessions. Paragraph [0047] of Hashemi states, "*One embodiment permits the users within a peer group to simultaneously chat while a media clip may advantageously be streamed from one user in the peer group to other users in the peer group*".

In light of Applicants' remarks on page 18 of the Applicant Response, U.S. Patent No. 7,120,687 ("Tessman") has been withdrawn as a prior art reference.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Alvesteffer whose telephone number is (571) 270-1295. The examiner can normally be reached on Monday-Friday 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stephen Alvesteffer
Examiner
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8-15-2007

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